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Applicant: LOWENSTEIN, M
Serial No: 08/422,360
Filed: 04/17/95
Group Art Unit: 2836
Examiner: HUYNH, K
Title: ELECTRICAL FILTER/PROTECTOR, AND METHODS OF
CONSTRUCTING AND UTILIZING SAME

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APPELLANT'S REPLY BRIEF
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Box AF
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In accordance with 37 CFR 1.193(b)(1), appellant respectfully files the present reply brief to the Examiner's Answer.

1. The section entitled "BACKGROUND" bridging pages 3 and 4 of the Examiner's Answer is inappropriate and should be stricken.

37 CFR 1.193(a)(1) states that the Examiner's Answer must be "a written statement in answer to appellant's brief including such explanation of the invention claimed and of the references and grounds of rejection as may be necessary".

The "BACKGROUND" section in the Examiner's Answer: is not in answer to appellant's brief; is not an explanation of the invention claimed; is not an explanation of the references; is not an explanation of the grounds of rejection; and did not appear in the final rejection.

Furthermore, it is respectfully submitted that 37 CFR 1.113(b) requires that the final rejection "repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof". The BACKGROUND section in the Examiner's Answer did not appear in the final rejection, and also violates the requirements of 37 CFR 1.193(b)(1) as indicated above.

It is respectfully submitted that such BACKGROUND section attempts to cover the same subject matter correctly set forth on page 2 of appellant's Second Brief on Appeal in the section entitled "STATUS OF CLAIMS". It should also be noted that on page 2 of the Examiner's Answer, Examiner admits that the statement of the status of the claims contained in appellant's brief is correct.

Why then does the Examiner's Answer introduce in the BACKGROUND section of the Examiner's Answer the Examiner's new version of the status of claims? Was this was done to introduce new arguments and material which were not stated in the final rejection?

Again, it is respectfully submitted that the final rejection must state all grounds of rejection and clearly state the reasons therefor.

2. The statement "Claims 22-41 have essentially the same limitations of claims 1-15 and 17-21 which had been decided by the Board of Appeals" (Examiner's Answer page 4) raises a new point of argument not stated in the final rejection.

The statement that "Claims 22-41 have essentially the same limitations of claims 1-15 and 17-21 which had been decided by the Board of Appeals" does not appear in the final rejection.

This violates 37 CFR 1.113(b) which requires that the final rejection state all grounds of rejection and clearly state the reasons in support thereof.

3. The statement "Claims 22, 26, 29 and 39 are rejected on the grounds of res judicata because despite a slight difference in wording, claims 22, 26, 29 and 39 contain the limitations of previously appealed claims 1-11 and 20-21; the rejection of which was affirmed by the Board of Appeals" (Examiner's Answer page 4, underlining added for emphasis) does not appear in the final rejection and raises a new point of argument.

The final rejection (page 2) alleges that claims 22, 26, 29 and 39 "essentially repeat the limitations as cited in appealed claims 1-11 and 20-21".

In contrast, the Examiner now alleges for the first time in page 4 of the Examiner's Answer that "claims 22, 26, 29 and 39 contain the limitations of previously appealed claims 1-11 and 20-21".

It is respectfully submitted that this violates 37 CFR 1.113(b) which requires that the final rejection state all grounds of rejection and clearly state the reasons in support thereof.

Furthermore, it is respectfully submitted that "essentially repeat" is different than "contain".

In the final rejection, the Examiner alleges that claims 22, 26, 29 and 39 "essentially repeat the limitations cited in the previously appealed claims".

Now, in contrast, and belatedly, the Examiner alleges in the Examiner's Answer that such claims "contain" such limitations.

Is the term "repeat" identical to "contain"? If so, what does "essentially repeat" mean?

It is respectfully submitted that "essentially repeat" is not identical to the term "contain"

which the Examiner now belatedly inserts by way of the Examiner's Answer.

4. The section entitled "SUMMARY OF PREVIOUSLY AFFIRMED CLAIMS 1-11 AND 20-21"(Examiner's Answer, pages 4-5), as a subsection of "(9) Prior Art of Record" (Examiner's Answer page 3), violates 35 CFR 1.193(a)(1) and should be stricken.

Such section: relates to claims which are not the subject of the present appeal: is not in answer to appellant's Brief; is not an explanation of the invention claimed; is not an explanation of the references; and is not an explanation of the grounds of rejection.

Therefore, it is respectfully submitted that such section violates 37 CFR 1.193(a)(1) and raises new points of argument, not stated in the final rejection, and should be stricken.

5. The section entitled "IDENTIFICATION OF EQUIVALENCE BETWEEN CURRENTLY APPEALED CLAIMS AND CLAIMS, THE REJECTION OF WHICH WAS PREVIOUSLY AFFIRMED" (Examiner's Answer pages 5-6), as a subsection of "(9) Prior Art of Record" (Examiner's Answer page 3), raises new points of argument, not stated in the final rejection and should be stricken.

It is respectfully submitted that all of the belated allegations set forth in the Examiner's Answer page 5, line 15 through page 6, last line, do not appear in the final rejection and raise new points of argument. Furthermore, it is respectfully submitted that this violates 37 CFR 1.113(b) which requires that the final rejection state all grounds of rejection and clearly state the reasons in support thereof.

6. The new allegation that "Claim 22 recites a device for eliminating current in a neutral wire having a completely passive parallel resonant circuit having three parallel branches, the circuit is tuned to third harmonic; the first, second and third branch consist of a capacitor, a reactor, and a resistor respectively" is incorrect, is not stated in the final rejection, and raises

new points of argument.

First, it is respectfully submitted that the exact wording of claim 22 is on appeal, and not the Examiner's incorrect and belated attempt at paraphrasing claim 22.

It is respectfully submitted that, in contrast to the Examiner's incorrect paraphrasing, claim 22 on appeal requires "In a multiple phase electrical system for supplying power from an AC source to one or more nonlinear loads connected to at least one phase line therein, a device for substantially eliminating currents in a neutral wire, said device comprising: a first completely-passive parallel resonant circuit having three passive electrical branches connected in parallel...." (underscoring has been added for emphasis).

It is respectfully submitted that the appeal is based on the exact wording of the claims on appeal, and not the Examiner's belated attempt at paraphrasing same, and which paraphrasing did not appear in the final rejection.

7. The belated allegation that "The limitations of claim 22 can be found in claims the combination of claims 1, 2, and 4; please note the restricting language that the device 'consisting' of three parallel branch, each branch having a passive component can be found in claim 7" (Examiner's Answer page 6) is incorrect, and does not appear in the final rejection.

Claims 1, 2 and 4 require "a first passive electrical component connected along a phase line in said electrical system in series with at least one of said nonlinear loads", and components which "substantially eliminate a harmonic current drawn by said at least one nonlinear load connected in series with said parallel connection of said first, said second, and said third passive electrical components"; whereas claim 22 does not require or recite these features.

In further contrast, independent claim 7 recites a device for substantially eliminating "a harmonic current generated by a nonlinear load in an electrical distribution system", "a first passive

electrical component connected in series with the nonlinear load”, and components which “change the current drawn by the nonlinear load”, all of which are not recited in claim 22.

In further contrast, claim 22 recites “In a multiple phase electrical system for supplying power from an AC source to one or more nonlinear loads connected to at least one phase line therein, a device for substantially eliminating currents in a neutral wire, said device comprising ... a first branch consisting of a capacitor, a second branch consisting of a reactor, and a third branch consisting of a resistor”; all of which are not recited in independent claim 7.

Furthermore, this new point of argument is not found in the final rejection which must state all grounds of rejection and clearly state the reasons in support thereof, as required by 37 CFR 1.113(b).

8. The new allegation that “Claim 26 recites the device of claim 22 is applied to each of phase line of a multiple phase electrical system, and the circuit is connected in series with the load”(Examiner’s Answer, page 6) raises a new point of argument, which is not stated in the final rejection.

Claim 26 depends from claim 22. Appellant respectfully incorporates herein by reference thereto the foregoing arguments set forth in the above paragraphs 6 and 7.

Furthermore, it is respectfully submitted that the present appeal involves the actual recitations in appeal claim 26, and not the attempted belated paraphrasing of claim 26 by the Examiner.

9. The belated allegation that “Claim 39 recites a device for eliminating current in a neutral wire” (Examiner’s Answer, page 6) is not only false, but it is not mentioned in the final rejection.

It is respectfully submitted that the Examiner’s statement that claim 39 recites a device for

eliminating current in a neutral wire is completely erroneous in view of the fact that claim 39 does not even mention a neutral wire.

10. The belated and inaccurate allegation that “The limitations of claim 39 can be found in claim 11” (Examiner’s Answer, page 6) is false, and not mentioned in the final rejection.

Claim 11 recites “a first passive electrical component connected in series with a nonlinear load”.

In contrast, claim 39 recites “a completely-passive parallel resonant circuit connected in series with said nonlinear load.”

11. “Please refer to pages 3-10 of the Decision for further detail” (Examiner’s Answer page 7) raises a new point of argument, not mentioned in the final rejection.

In contrast, please note that the final rejection at page 2 refers to pages 3-8.

12. The belated contention that “The examiner submits below the rejection of claims 1-11 and 20-21 in its entirety as applied to currently appealed claims 22, 26, 29, and 39” (Examiner’s Answer, pages 7-9) raises new points of argument, not mentioned in the final rejection.

Here, for the first time, the Examiner relies on another Examiner’s Answer (Paper No. 14) submitted by Examiner Sally Medley, rather than the Board’s decision mentioned in the final rejection.

This is inappropriate and misleading because: the Board rejected certain claims and reversed other claims; the record in the prior appeal is different than the record presently before the Board; and the claims are not identical.

The final rejection asserts, for the first time, the ground of res judicata. Appellant respectfully traverse this belated res judicata rejection for the reasons set forth below.

The final rejection fails to make any showing of an identity of the issues presented for

adjudication and the issues previously decided. Res judicata requires a showing of an identity of the issues presented for adjudication and issues previously decided. In re Hellbaum, 54 CCPA 1051, 371 F.2d 1022, 152 USPQ 572 (1967); In re Fried, 50 CCPA 954, 312 F.2d 930, 136 USPQ 429 (1963). Here, there is no such identity of such issues, and in addition, the final rejection fails to make any showing or even assert any alleged identity of such issues.

The claims considered by the Board in Appeal No. 1997-1187 are not identical to the claims rejected by the present final rejection.

Furthermore, there is no identity between the record previously before the Board and the record herein.

There is also no identity between the evidence as a whole previously before the Board, and the evidence as a whole herein, including the evidence of secondary considerations going to the issue of obviousness/nonobviousness. Such evidence of secondary considerations going to the issue of obviousness/nonobviousness must be considered prior to reaching a conclusion of obviousness/nonobviousness, and such evidence was not previously before the Board. In re Herr, 377 F.2d 610, 153 USPQ 548 (CCPA 1967); In re Russell, 169 USPQ 426 (CCPA 1971); Fromson, 755 F. 2d at 1556-57, 225 USPQ 32; W.L. Gore, 721 F.2d at 1555, 220 USPQ 314.

In addition, even if the final rejection made a showing of identity of the issues presented for adjudication and the issues previously decided which is required by a proper rejection of res judicata (which the final rejection does not), the rejection on the ground of res judicata had been waived by the Examiner. If res judicata was applicable in the present case, the Examiner should have made such rejection in the first Office Action, and indeed should have made such first Office Action on the ground of res judicata as a final rejection, which the Examiner did not. Thus, for this reason alone, it is respectfully submitted that the belated rejection on the ground of res judicata has been waived. In re Kaghan, 387 F.2d 398, 156 USPQ 130 (CCPA 1967).

13. **“The appellant rehashes arguments which had been presented and decided by the Board of Appeal in Decision rendered 7/25/00” (Examiner’s Answer, page 9) raises new points of argument, which have never been presented in the final rejection.**

In addition, the Examiner does not specify or identify which arguments have allegedly been rehashed and presented and decided by the Board of Appeals.

14. **The new allegation that “Because the arguments contained in the current Brief had been considered and addressed in both Examiner’s Answer (Paper No. 14) and Board’s Decision (Paper No. 23), the examiner will respond to the appellant’s arguments by reinstating the discussions found in both of these papers” (Examiner’s Answer, page 9) raises new points of argument, not mentioned in the final rejection.**

It is respectfully submitted that the Examiner’s allegations are not only improper, but false.

For example. Papers Nos. 14 and 23 never considered and/or addressed the ten issues mentioned in the Appeal Brief herein, nor any of the arguments in support of such issues.

In addition, the records herein, including the Declarations filed therein, were not before the prior Board.

15. **The new allegation that “Since the declarations of Lowenstein, Kraus, and Pirrone are directed to the commercial success of the product and since the Kraus and Pirrone are corroborative declarations and the Kraus and Pirrone declarations are corroborative of the Lowenstein declaration, the Examiner considered them as a single declaration in the final rejection” (Examiner’s Answer, page 19) raises new points of argument, and is incorrect.**

In contrast, Paper No. 41, page 2, states that “Issues 4-5, item 4(b) of the Final Rejection of 9/10/01 applies to all three declarations by Lowenstein, Kraus and Pirrone” (underlining added for emphasis).

Moreover, it should be noted that the Declarations involved are not merely Declarations

directed to the commercial success of the invention. In contrast, please note that the Declaration of Michael Lowenstein is entitled "Declaration Re Commercial Success and Acclaim".

16. The language "As for the declarations of Lowenstein, Kraus, and Pirrone are not germane to the rejection at issue" (Examiner's Answer, page 20) is false, is not stated in the final rejection, raises new issues of argument, and is not a sentence.

It is respectfully submitted that such Declarations are very germane to the 35 USC 103 rejection, if the Examiner is still maintaining such rejection.

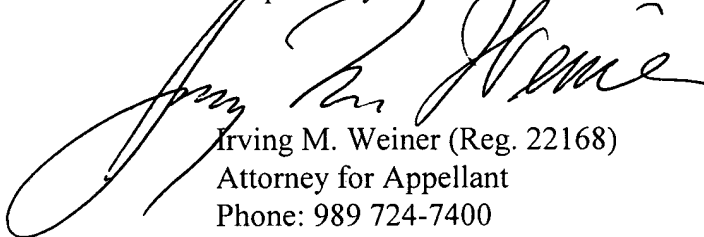
17. The Examiner's Answer is replete with many other new points of argument, not stated in the final rejection.

In order not to unduly increase the size of this Reply Brief, suffice it to say that the reference to the final rejection and the Examiner's Answer shows a myriad of other new allegations too numerous to deal with.

Appellant encloses herewith three copies of the Appellant's Reply Brief.

Favorable consideration is respectfully requested.

Respectfully submitted,

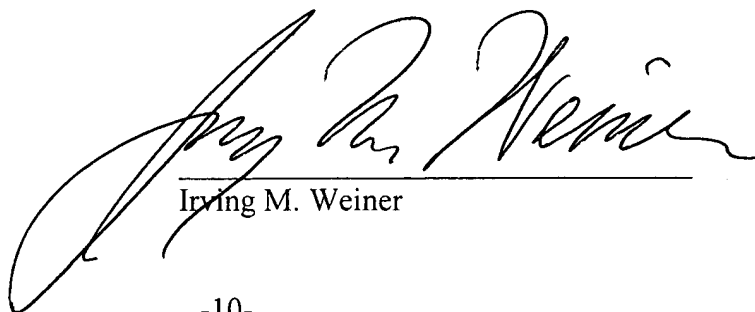


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Certificate of Mailing

I hereby certify that three copies of the foregoing Appellant's Reply Brief were sent to Box AF, Assistant Commissioner for Patents, Washington, D.C. 20231, on January 21, 2003 by first class mail.



Irving M. Weiner